IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Robert M. Levin
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For: Sesquip[tm]

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Group Art Unit 3711
Examiner: Dolores R. Collins

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Commissioner for Patents
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ATTENTION: Board of Patent Appeals and Interferences

APPELLANT'S REPLY BRIEF (37 C.F.R. 41.41)

The sole claim on appeal is as follows:

Claim 1. *An educational method for increasing a student's vocabulary comprising the steps of:*

*identifying a first expression consisting of a commonly kown person, place, thing, event, title, phrase, or quote consisting of one or more words in tangible form;*

*obscuring said words by substituting one or more of said words with lesser known words to form a second expression;*

*presenting the second expression to a student in tangible form to decipher using his vocabulary knowledge of said lesser known words;*

*providing said student with one or more definitions in tangible form of the lesser known words which definitions serve as clues for deciphering the second expression back into the first expression; and,*

*scoring the student based on the number of the definitions in tangible form used to decipher the second expression back into the first expression*

*whereby said student learns the lesser known words and adds them to his vocabulary by actively using said definitions of the lesser known words in deciphering the second expression back into the first expression.*

The bulk of the Examiner's Answer is that the claim is not to a machine or transformation and therefor not patentable subject matter. Applicant conceded that in its brief

which obfuscates the real issue: Is the claim written such that it claims the idea as opposed to a substantial practical application of the underlying idea?

The examiner chastised the applicant for amending claim 1 in an effort to overcome the rejection under 35 USC 101 which was raised after a 102/103 rejection was reversed on the first appeal. In reply, applicant notes that the parent application was filed on February 24, 2004 and the law has changed. Applicant has amended the claim to adjust to those changes and the amendment is supported by the spcification.

The heart of the rejection as stated in the Examiner's Answer is: "Applicant's claimed method, while arguably reciting a number of physical steps, is viewed here as an attempt to claim a new set of rules for playing a game...a set of rules qualifies as an abstract idea."

Claim 1 does not claim a set of rules, i.e., every "substantial practical application" of the idea which underlies the teaching method. Protection is only sought for the teaching method in conjunction with all of the other steps in the claimed process, i.e., words and clues are all presented in tangible form only. Applicant's claim does not preempt all practical uses of the idea or preempt the teaching concept, just when it is practiced in a tangible copyrightable form such as in a newspaper, puzzle book, computer, Internet or other such media.

As stated in Applicant's Brief on Appeal, the method of claim 1 produces a "useful, concrete and tangible result" and therefore is patentable. Harping that it does not relate to a machine or transformation does not address applicant's reasoned statement:

Applicant's method is "useful" because the utility of the steps is (i) specific, (ii) substantial and (iii) credible. Not all students will learn but not all patients who take a prescribed drug get well either but a method of treatment is patentable subject matter.

Applicant's method produces a "tangible" result. The real-world result is that the

student learns a new word or words which result is testable.

Applicant's method produces a "concrete" result. If the student is engaged he will predictably learn which result is testable.

Accordingly, withdrawal of the rejection under Section 101 and passage of the claim to allowance are respectfully requested.

Respectfully submitted,

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CERTIFICATE OF TRANSMISSION

I hereby certify that this Appellant's Brief is being electronically transmitted to the Patent and Trademark Office by EFS-Web on April 23, 2012.

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